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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

THE MAGNAVOX COMPANY,
a Corporation, and
SANDERS ASSOCIATES, INC.,
a Corporation,

Plaintiffs,

v.

CHICAGO DYNAMIC INDUSTRIES,
INC., et al,

Defendants.

CONSOLIDATED CIVIL
ACTIONS NOS.

74 C 1030

74 C 2510

THE DEFENDANTS' MEMORANDUM
ON AUTHORITIES AND FACTUAL ISSUES

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THE DEFENDANTS' MEMORANDUM
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The purpose of this memorandum is to provide the Court with an outline of the statutory and judicial authorities to be applied in this case, to set out the facts these defendants will prove and to demonstrate the application of the authorities to those facts.

Departing from the usual custom in presentation of memoranda of this kind, the authorities and facts are set forth in the outline form that follows.

I. The Authorities With Respect To Validity

A. The Pertinent Statutes and Rules

1. The Statutes

The patent is valid unless it is anticipated under any of the subdivisions of 35 U.S.C. § 102 or "obvious" in accordance with the provisions of 35 U.S.C. § 103.

"35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

"(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. "

In addition, for a patent to be valid the requirements of 35 U.S.C. § 112 must also be met, and these requirements are as follows:

"35 U.S.C. 112. Specification. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

2. The Rules

When a patent application is filed it is "examined" by the Patent Office in an ex parte proceeding to determine whether the statutory requirements as interpreted by the United States Courts have been met, and whether the rules of the Patent and Trademark Office have been complied with. This examination itself is required to be conducted in accordance with those rules. A failure to comply with them can also result in the patent being held invalid, for the rules of the Patent Office, when consistent with law, have the full force and effect of statute. Hadco Products, Inc. v. Lighting Corp. of America, Inc., 312 F.Supp. 1173, 1181 (E.D. Pa. 1970); vacated on other grounds 462 F.2d 1265 (3 Cir. 1972).

"75. Claim(s).

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See rule 58(a).)"

"133. Interviews. (a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in rule 111, 135."

3. Presumption of Validity

A patent, according to statute, is presumed valid and the burden is on the defendants to establish invalidity.

"35 U.S.C. §282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any

action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. July 19, 1952, c. 950, §1, 66 Stat. 812."

However, the presumption of validity does not exist as against evidence of prior art not before the Patent Office. Rockwell v. Midland-Ross Corporation, 438 F.2d 645, 650 (7 Cir. 1971). Likewise, it has been held that where the

Patent Office has been misled as to the true import of the prior art the presumption of validity does not attach. Kahn v. Dynamics Corp. of America, 508 F.2d 939, 942 (2 Cir. 1975). See also Metallurgical Exoproducts v. Pittsburgh Metals Purifying Co., Inc., 393 F.Supp. 1104 (W.D. Pa. 1975).

B. Judicial Construction of the Statute

1. Prior Publication, Use or Sale

What constitutes a printed publication, knowledge or use which will render a patent invalid has been decided numerous times by the Courts.

In Popeil Bros., Inc. v. Schick Electric, Inc., 494 F.2d 162 (7 Cir. 1974) the Court at page 164 said:

"In essence § 102(a) requires that a method or device, in order to be patentable, be novel. Under the statute such novelty is lacking where a purported invention has been anticipated by a foreign or domestic patent or printed publication or domestic knowledge or use prior to the inventor's date of invention."

On the issue as to what is a publication, the Court at page 166 said:

"To constitute a printed publication for purposes of the publication bar, all that is required is that the document in question be printed and so disseminated as to provide wide public access to it. (Citing authority). The

key factor is not access by a significant segment of the public, or number of persons, or even by any specific means, but simply distribution of any segment of the public. (Citing authority)"

In Deep Welding, Inc. v. Sciaky Bros, Inc., 417 F.2d 1227, 1235 (7 Cir. 1969) our Court of Appeals held that various articles and conference papers which cumulatively described the patented process were printed publications and, therefore, were evidence of prior art because they were distributed to "persons skilled in the art under consideration".

It will be shown that included in the prior art not considered by the Patent and Trademark Office any time it had the applications for the patents in suit before it were certain public uses at Ypsilanti, Michigan, in 1954 and Princeton, New Jersey, in 1967. Each of these public uses took place more than one year before the applications were filed. Such public uses are "statutory bars" in accordance with provisions of 35 U.S.C. § 102(b). A public use is a single use for profit not purposely hidden. See Magnetics, Inc. v. Arnold Engineering Co., 438 F.2d 72, 74 (7 Cir. 1971). See also Dempster Brothers, Inc. v. Borg-Warner Corp., 170 F.Supp. 488, 494 (E.D. Tenn. 1958).

With respect to the "on sale" provisions of § 102 in Amphenol Corp. v. General Time Corp., 397 F.2d 431 (7 Cir. 1968) the court held an effort to sell a patented device even at an early stage in development history is a bar to the patent when that effort is motivated by a desire to gain a competitive edge.

2. The Prior Art and Obviousness

A purported invention not anticipated under 35 U.S.C. § 102 may still be invalid as "obvious" under the provisions of 35 U.S.C. § 103.

The distinction between the defense of obviousness and the defense of anticipation is set forth in Popeil, 494 F.2d at page 167, as follows:

"The defense of obviousness challenges the inventiveness of the purported invention rather than, as with anticipation, its novelty. The question to which the defense addresses itself is whether on the basis of the determined differences between the prior art and the claims at issue, 'a hypothetical person having ordinary skill in the art would have found the same solution when addressing himself to the same problem.' (Citing authority) This requirement is less stringent than the substantial identity between prior art and the purported invention which is required to find anticipation. Thus prior art which is insufficiently similar to anticipate a purported invention may still render it obvious. (Citing authority)"

Every defense available against a patent under § 102 of the statute is equally available under § 103 of the statute. Hazeltine Research v. Brenner, 382 U.S. 252 (1965); Sutter Products Co. v. Pettibone Mulliken Corp., 428 F.2d 639 (7 Cir. 1970). In Hazeltine the petitioners had suggested that a defense under § 102(e), a prior patent application, was not available as evidence of obviousness under § 103 since the prior application was not publicly available. The Supreme Court held that this distinction was without significance stating at page 256:

"To adopt the result contended for by petitioners would create an area where patents are awarded for unpatentable advances in the art. We see no reason to read into § 103 a restricted definition of 'prior art' which would lower standards of patentability to such an extent that there might exist two patents where the Congress has plainly directed that there should be only one."

The Seventh Circuit in Sutter Products followed Hazeltine when it rejected an argument by the plaintiff in that case that prior invention under § 102(g) may not be considered prior art to show obviousness under § 103.

3. The Proper Standard of Invention

In Graham v. John Deere Co., 383 U.S. 1 (1965) the Supreme Court set forth the factual inquiries which should

be made by a trial court when addressing itself to the issue of obviousness under 35 U.S.C. § 103. Thus at 383 U.S. pages 17, 18 and 19 the Court spoke as follows:

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

* * * * *

Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirement of § 103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in § 103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. Technology, however, has advanced - and with remarkable rapidity in the last 50 years. Moreover, the ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an evenhanded application to require that those persons granted the benefit of a patent monopoly be charged with an awareness of these changed conditions. The same is true of the less technical, but still useful arts. He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office."

The Seventh Circuit requires complete findings with respect to the Graham factual inquiries. Gass v. Montgomery Ward & Co., 387 F.2d 129 (7 Cir. 1967).

4. The Standards For A Combination of Old Elements

The defendants will prove that each and every element or "means" claimed in the patents in suit was in the prior art and functioned there in the same fashion as they do in the device as claimed.

The Supreme Court in A & P Tea Co. v. Supermarket Corp., 340 U.S. 147 (1950), said at page 152:

"Courts should scrutinize combination patent claims with a care proportional to the difficulty and improbability of finding invention in an assembly of old elements. The function of the patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." (Emphasis supplied)

That standard has never changed. Thus in

Anderson's-Black Rock v. Pavement Co., 396 U.S. 57 (1969) at page 61, the Court said:

"A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters 'without invention will not make patentability'."

Most recently in Sakraida v. Ag Pro, Inc., 44 U.S.L.W. 4477, 189 USPQ 449 (1976), the Supreme Court strongly restated the principles of A & P Tea Co. and Anderson's-Black Rock. At page 453 the Court held even if the combination produces "a more striking result" that is not sufficient.

In another recent decision the Supreme Court in addressing itself to the question of obviousness, particularly with respect to "a person having ordinary skill in the art to which the subject matter pertains" said in Dann v. Johnston, 44 U.S.L.W. 4463, 189 USPQ 257 (1976) at page 261 as follows:

"In making the determination of 'obviousness' it is important to remember that the criterion is measured not in the terms what would be obvious to a layman but rather what would be obvious to one 'reasonably skilled in [the applicable] art'. Graham, supra, 383 U.S. at 37, 148 USPQ at 474. In the context of the subject matter of the instant case, it can be assumed that such a hypothetical person would have been aware both of the nature of the extensive use of data processing systems in the banking industry and of the system encompassed in the Dirks patent. While computer technology is an exploding one, '[i]t is but an evenhanded application to require those persons granted the benefit of a patent monopoly be charged with an awareness' of the technology."

In Goldman v. Bobins, 245 F.2d 840 (7 Cir. 1957) our Court of Appeals held at page 843 that the mere production

of an advantageous result simply by carrying forward features selected from the prior art and incorporating them into a single structure wherein such features perform their obvious functions is not an invention. See also Solar Corporation v. Borg-Warner Corporation, 244 F.2d 940 (7 Cir. 1957).

It is manifest that the standard of patentable invention is the same for all United States Courts. When a combination of elements old in the art function in the claimed combination precisely in the same manner in which they function in the prior art and there is no synergistic result, the requirements of 35 U.S.C. § 103 have not been met and the patents in issue are invalid.

II. The Patents in Suit are Invalid

A. The Subject Matter of This Litigation

These patents in suit are concerned with apparatus for displaying symbols on a standard television receiver which includes electrical circuits with operator controls so that the symbols may be moved about. Such receivers have been sold throughout the world since the close of World War II. Television receivers display a picture or symbols upon a cathode ray tube (CRT).

In a standard television receiver whatever is displayed is produced by using a scanning technique referred to as a raster scan. A standard television raster scan is one in which an electron beam moves back and forth across and progressively down the CRT display area (the screen). The scanning pattern is controlled by electrical synchronizing signals which control circuits to make the electron beam deflect along a fixed path. In this manner the entire screen is scanned. The scanning is done rapidly so that a viewer can detect only the desired image.

A standard television receiver includes a cathode ray tube and electrical circuits which receive picture (video), sound (audio) and synchronizing signals broadcast at radio frequencies (RF) and extract those signals from the broadcast signal so that the picture and the sound are presented to the viewer.

Cathode ray tubes are also used for other purposes; for instance, they are used in laboratories as oscilloscopes. Laboratory oscilloscopes do not use raster scan techniques; instead the electron beam is caused to follow a path corresponding to the pattern to be displayed. Thus, if the user wants to see how the magnitude of an electrical voltage changes over a period of time that voltage is connected as an

input to the oscilloscope and the electron beam traces a path on the screen of the cathode ray tube which corresponds to changes in that voltage. This is sometimes referred to as an X-Y deflection system.

Other uses of cathode ray tubes include the display of letters of the alphabet and numbers such as one would encounter in a hotel or airlines reservation office or in a stockbroker's office. Still other uses for cathode ray tubes are for the display of various kinds of symbols in simulators used to train people for such jobs as pilots, gunners and the like, as well as nonmilitary applications. Cathode ray tubes in these kinds of applications may use either raster scan techniques or the X-Y deflection system.

With more specific reference to the patents in suit, they are concerned with electrical circuits for generating symbols and displaying them on the screen of a television receiver cathode ray tube. Controls are provided for those circuits so that a user can play games by moving the symbols around. Other circuits electrically detect when the symbols are "coincident", that is, touch each other so that one symbol will bounce away from the other in a particular way.

B. The Patents in Suit

1. Patent Nos. 3,659,284 and Re. 28,507 (the '507 patent)

The original application for this patent was filed on May 27, 1969. It is concerned in large part with playing "ball" type games on television receivers. To that end it discloses electrical circuits for producing the desired symbols and maintaining or synchronizing the standard television raster scan pattern on the screen of the television tube. The symbol signals and the synchronizing signals are combined (the composite video) and used to vary the amplitude (modulate) of an RF signal. The modulated RF signal is connected directly to the antenna terminals of a television receiver. The television receiver processes this signal in precisely the same way it would process the composite video signal received from a broadcast station in order to display the symbols on the screen of the CRT.

The particular circuits disclosed in the patent generate and display a so-called "hit" symbol which, when it is apparently hit or contacted by a so-called "hitting" symbol, is caused to move in certain specified ways. The patent also discloses what it calls "wall bounce". That is, a circuit which is effective when a "ball symbol" hits a predetermined limit on a TV screen to cause the ball to bounce back into the field of play.

2. Patent Nos. 3,659,285 and Re. 28,598
(the '598 patent)

The original application for this patent was filed on August 21, 1969. Apart from some differences in the electrical circuits used, this patent is very similar to the '507 patent. In this patent the "wall bounce" feature is supplemented by providing a circuit to generate an actual wall symbol so that games suggestive of handball or volleyball may be played.

C. The Prior Art

1. Prior Art Not Considered by the Patent Office

The defendants will prove that prior to the patentees' dates of invention and/or more than one year prior to the filing of the applications for the patents, every significant element or "means" included in the devices which the patentees claim as their invention was in the prior art.

Starting from at least as early as 1954 and continuing to this day, numbers of people were and are publicly using the CRT's in conjunction with computers to play games of all types. One such game was publicly played at the University of Michigan's Engineering Research Center in 1954. Using a computer to produce the necessary electrical

signals and providing controls for an operator to aim a cue ball a pool game was played on a CRT. In this game, when a ball symbol hit another ball symbol or the sides of the pool table, the symbols would bounce or rebound in a realistic fashion. When a ball was hit into a "pocket" the ball would disappear from the playing surface precisely as in a real game.

Another pool game was played publicly at the Sarnoff Research Center of the RCA Corporation at Princeton, New Jersey, in the latter part of September 1967. This activity was, of course, more than one year prior to the original filing dates of the patents in suit and, therefore, is part of the prior art in accordance with the provisions of 35 U.S.C. § 102(b) which reads as follows:

"A person shall be entitled to a patent unless--

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or".

This pool game differed in some respects from the University of Michigan pool game. In the RCA pool game the pool balls were numbered 1 through 15 and the apparatus included means for generating and displaying the sides and

pockets of the pool table. The cue ball was set into motion by the use of a "light pencil". Electrical circuitry recognized the point on the periphery of the cue ball that was touched by the pen and caused the ball to go into motion along the line constituting an extension of the radius from that point to the center of the cue ball. In this manner the cue ball was aimed. When the cue ball hit another pool ball, that is, when there was coincidence, the other ball would start in motion in a realistic fashion. If the cue ball or one of the other pool balls hit the side of the table they would bounce back into the field of play with an angle of reflection equal to an equal of incidence.

The occasion for the playing of pool at RCA's laboratories was a celebration of the 25th anniversary of those laboratories. In commemoration of that event RCA conducted two "open houses". At the first of these a number of "VIPs", people from industry, government and the academic world, were invited. At the second, employees of the laboratories were given a number of tickets to pass out to their friends and neighbors without limitation, and approximately 8,000 people attended. At each of these open houses there were a number of demonstrations. One of these demonstrations was the pool game.

Both Michigan pool and RCA pool were therefore public uses in the United States more than one year prior to the dates of the applications for the patents in suit.

In the early 1960's the game called "Space War" was played at MIT and Stanford University, again using a computer and a CRT. In this game one player, controlling his rocket ship symbol, attempted to shoot down the rocket ship symbol of his opponent by firing projectiles. When the opponent's rocket ship was hit (coincidence) it would disappear from the screen.

Concurrently with the computer game activity, persons concerned with the display and movement of symbols on CRT's had perfected the use of raster scan techniques for that purpose. Evidence of this will be found in the work of Kaiser Aero Space & Electronics Corporation and its issued patents including Patent Nos. 3,122,607 issued on February 25, 1964, and Re. 25,756 issued on April 6, 1965.

As has been described above, the patents in suit are not concerned with the general concept of playing games on a television receiver. They are concerned with specific games and electrical circuits. The reason for this is that another patent, Patent No. 3,728,480, owned by the plaintiff Sanders

and licensed to the plaintiff Magnavox, issued on April 17, 1973, on an application filed January 15, 1968. That patent is concerned with the general concept of game playing on television receivers. The disclosure of that patent is prior art in accordance with the provisions of 35 U.S.C. § 102(e) which reads as follows:

"A person shall be entitled to a patent unless--

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or".

It is possible that the plaintiffs will contend that the alleged inventions of the '507 and '598 patents were made before January 15, 1968, the filing date of the application for the '480 patent. It is possible that they will be able to carry their burden of proof. However, even if this should prove to be the case the evidence will show that the alleged invention of the '480 patent was made prior to the invention dates of the patents in suit. Thus, the "prior invention" of Ralph H. Baer, alone, in the '480 patent is prior art in accordance with the provisions of 35 U.S.C. §102(g):

"A person shall be entitled to a patent unless--

"(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

The public uses, prior knowledge, publications and prior inventions will be proven beyond any doubt. Just as Patent No. 3,728,480 is prior art to the '507 and '598 patents, the '507 patent is prior art with respect to the '598 patent under 35 U.S.C. §§ 102(e) (g) and 103.

2. The Prior Art Now Known Destroys the Presumption of Validity

As we have stated earlier, when there is shown to be prior art which is better than that considered by the Patent Office, the presumption of validity is weakened if it does not disappear altogether. To appreciate the significance of this rule in these cases, the arguments advanced by the patentees through their attorneys to persuade the Patent Office to issue the patents in suit are illuminating.

In application Serial No. 697,798, filed January 15, 1968, the parent of the application for the '480 patent, a patent to Hermann No. 3,046,676 was distinguished

by arguing that it did not show means for synchronizing a television raster scan. (File History of application Serial No. 697,798, page 67.) This same argument was made to the Patent Office when the plaintiffs sought to reissue the '284 and '285 patents. (File History of application for reissue No. Re. 28,507 and File History of application for reissue No. Re. 28,598.)

Another argument made to the Patent Office in connection with the '284 patent was that none of the references considered by the Examiner showed a means for generating a hit symbol and the cooperation of that symbol with a so-called hitting symbol (a bounce or a rebound). (File History of the '284 patent, Amendment B, page 19.)

These arguments and variations on them run throughout patentees' representations to the Patent Office when they were trying to obtain the patents. The prior art now available discloses such features. It is, therefore, more pertinent and closer to the claimed subject matter than is anything considered by the Patent Office. Under these circumstances there is no presumption of validity in these cases.

D. The Patents in Suit are Invalid

Simply stated, each and every element of the claims sued upon is old in the art and was used in the prior art for precisely the same purpose that it was used in those claims.

For example, all but one of the elements of claim 25 of the '507 patent may be found in the prior work and invention of Mr. Baer. That prior work did not include circuits which upon coincidence between two spots imparted a "distinct motion" to one of the spots as specified in the '507 patent. However, in the Michigan and RCA pool games we find there was precisely such a means as called for by the claim.

The same is true of claim 2 of the '598 patent. In this case the prior work and invention of Baer included every element of this claim except that in this case a movable symbol moved away from a fixed symbol. This is nothing more than the ball bouncing off of the sides of the pool table as in the RCA pool game.

It will be shown that by 1967 the generation of symbols on cathode ray tubes and the provision of means to permit game players to manipulate those symbols so as to play all kinds of games was well known. It will be shown that the concept of playing games on home television receivers is not

the invention of the patents in suit. Thus, in the end there are no differences between the claims of the patents in suit and the prior art, and the level of skill in the art was such that it would have been obvious in 1968 to persons of ordinary skill to make additions to the prior art work of Baer which used elements of the computer game prior art operating just as they did before.

III. The Patents in Suit Are Not Infringed

A. The Law With Respect to Infringement

The plaintiffs concede that it is their burden to prove infringement. See Becker v. Webcor, Inc., 289 F.2d 357 (7 Cir. 1961). In Skirow v. Roberts Colonial House, Inc., 388 F.2d 391 (7 Cir. 1966) the court at page 391 held as follows with respect to the test whether or not there is infringement:

"Neither a literal application of claim phraseology nor similarity of result is sufficient to establish infringement. There must be a real identity of means, operation, and result. (Citing authority)"

To the extent that plaintiffs will rely upon the "doctrine of equivalents" the standards set out in Fife Manufacturing Company v. Stanford Engineering Co., 299 F.2d 223 (7 Cir. 1962) must be applied. Thus, at page 226 the

court said:

"What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case.' (Citing authority) Where the patent is found in a crowded art, the doctrine of equivalents is given a narrow range. Parmelee Pharmaceutical Company et al v. Zink, 8 Cir., 285 F.2d 465."

It will be seen that many of the claimed elements are set forth in the form of "means for" performing one kind of function or another. Under these circumstances the statute mandates that the doctrine of equivalents must be considered. Thus, 35 U.S.C. § 112, ¶ 3, reads as follows:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

B. Why the Accused Devices Do Not Infringe

The plaintiffs will not be able to prove that any of the coin operated games they charge to infringe can be used in combination with television receivers. Likewise, they will not be able to prove that there is any interaction between spots movable across the screens of any of the accused devices which is in any way similar to whatever interaction the patents in suit disclose, nor will they be able to prove that the apparatus

used by the defendants to provide interaction between moving spots in anything like the apparatus disclosed in the patents.

IV. Commercial Success and Long Felt Need Are Irrelevant in This Case

Commercial success and long felt need do not exist in the present case. These items are sometimes referred to as secondary considerations in the event that the issue of obviousness is in doubt. Such considerations do not exist in this case as there has been no long felt want, nor will the plaintiffs demonstrate commercial success of the type referred to in the decisions.

Assuming arguendo that secondary considerations existed and were relevant, they cannot overcome a conclusion of obviousness. The Supreme Court stated in the A & P case, 340 U.S. 147 (1950), at page 153:

"The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability."

To the same effect is Goldman v. Bobins, 245 F.2d 840, 844 (7 Cir. 1957).

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